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10/565,029	09/11/2006	John Rose	10557/324491	9169
30559	7590	07/28/2008	EXAMINER	
CHIEF PATENT COUNSEL			PEPITONE, MICHAEL F	
SMITH & NEPHEW, INC.				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/565,029	ROSE, JOHN	
	Examiner	Art Unit	
	MICHAEL PEPITONE	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 11 September 2006.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-58 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-58 is/are rejected.

7) Claim(s) 12 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/20/06, 6/1/07, 3/13/08, 1/10/08, 4/9/08, 7/15/08.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

Claim Objections

Claim 12 is objected to because of the following informalities: The typo “220GPa” should be “22 GPa” {as per specification (pg. 2, ln 15-16)}. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*,

86 USPQ 481 (Bd. App. 1949). In the present instance, claim 6 recites the broad recitation at least 75%, and the claim also recites 80, 85, 90, or 95% which is the narrower statement of the range/limitation.

Claims 10-12 recites the limitation "the fibres" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 and 17-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuan *et al.* (US 6,303,697).

Regarding claims 1-8 and 10-12: Yuan *et al.* teaches a biocompatible polymeric composite (1:7-12; 3:60-4:8) comprising a copolymer containing from about 50 to about 100 mol% glycolide {glycolic acid} and lactide {lactic acid} [instant claims 1-8] (7:48-8:5), with a 10/90 polylactide-co-glycolide (PLA/PGA) copolymer (10:6-25) as a preferred embodiment having a tensile strength of 143.9 ksi {about 992 MPa} ; and a tensile modulus of 2100 ksi {about 14.5 GPa} (11:15-30).

The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents. Therefore, the claimed effects and physical properties, i.e. a tensile strength of at least 1100 MPa [instant

claim 1] and a tensile modulus of at least 22 GPa [instant claims 10-12], would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Regarding claims 9 and 17-21: Yuan *et al.* teaches a composite comprising drawn {strengthened} PLA/PGA fibers [instant claims 9 and 17] (10:40-50) and a bioabsorbable polymer matrix {poly-caprolactone} [instant claims 18, 20-21] (8:33-45), wherein a prepreg is formed comprising a volume fraction of 45-50% [instant claim 19] (13:43-57).

Regarding claims 22-23: Yuan *et al.* teaches a composite comprising biostable polymers [instant claim 22], such as polypropylene [instant claim 23] (6:57-7:18).

Regarding claims 24-27: Yuan *et al.* teaches bone regenerating growth factors [instant claims 24-27] (9:26-39).

Regarding claims 28-29: Yuan *et al.* teaches orthopedic devices {joint replacement prosthesis} [instant claims 28-29] (9:19-25).

Regarding claims 30-37: Yuan *et al.* teaches a method of manufacturing a polymeric composite comprising impregnating polymeric biocompatible fibers (PLA/PGA copolymer) (10:6-67) {which were subjected to a drawing procedure} with a matrix material, wherein the matrix material is a solution of polycaprolactone {formation of a prepreg}, and consolidating the perform using a compression molder, [instant claims 30-37] (5:15-36; 5:56-67; 9:40-45; 9:65-67)

to afford a composite with no voids, uniform fiber distribution and superior composite properties.

The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents. Therefore, the claimed effects and physical properties, i.e. a tensile strength of at least 1100 MPa [instant claim 31], would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-14, 16, 38-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Yuan et al.* (US 6,303,697) as applied to claim 1 above, and further in view of *Jamiolkowski et al.* (US 4,700,704).

Regarding claims 13: *Yuan et al.* teaches the basic claimed composition [as set forth above with respect to claim 1], wherein the polymer composition is formed by a fiber comprising a PLA/PGA copolymer, and subjecting the fibers to a drawing procedure (7:19-47; 10:6-47).

Yuan *et al.* does not teach quenching the fibers after extrusion [instant claim 13]. However, Jamiolkowski *et al.* teaches a polymeric composition comprising copolymers of glycolide and caprolactone (1:10-16), wherein the copolymer is melt spun and extruded into a quench bath {ice water} prior to drawing [instant claim 13] (9:44-55). Yuan *et al.* and Jamiolkowski *et al.* are analogous art because they are concerned with a similar technical difficulty, namely the preparation of fibers of glycolide copolymers. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined a quench bath, as taught by Jamiolkowski *et al.* in the invention of Yuan *et al.*, and would have been motivated to do so since Jamiolkowski *et al.* suggests that such glycolide copolymer monofilaments prepared with a quench bath provide synthetic surgical articles having desirable tensile strength, controllable absorbability, and suitable in vivo strengths (2:23-33), and is an equivalent alternative means of providing fibers of glycolide copolymers.

Regarding claim 14: Yuan *et al.* teaches melt extrusion (10:14-25).

Regarding claim 16: Yuan *et al.* teaches drawing steps performed under different conditions (7:24-35; 10:14-47).

Regarding claims 38-42: Yuan *et al.* teaches a composite comprising drawn {strengthened} PLA/PGA fibers [instant claims 38] (10:40-50) and a bioabsorbable polymer matrix {poly-caprolactone} [instant claims 39, 41-42] (8:33-45), wherein a prepeg is formed comprising a volume fraction of 45-50% instant claim 40] (13:43-57).

Regarding claims 43-44: Yuan *et al.* teaches a composite comprising biostable polymers [instant claim 43], such as polypropylene [instant claim 44] (6:57-7:18).

Regarding claims 45-48: Yuan *et al.* teaches bone regenerating growth factors [instant claims 45-48] (9:26-39).

Regarding claims 49-50: Yuan *et al.* teaches orthopedic devices {joint replacement prosthesis} [instant claims 49-50] (9:19-25).

Regarding claims 51-58: Yuan *et al.* teaches a method of manufacturing a polymeric composite comprising impregnating polymeric biocompatible fibers (PLA/PGA copolymer) (10:6-67) {which were subjected to a drawing procedure} with a matrix material, wherein the matrix material is a solution of polycaprolactone {formation of a prepreg}, and consolidating the perform using a compression molder, [instant claims 51-58] (5:15-36; 5:56-67; 9:40-45; 9:65-67) to afford a composite with no voids, uniform fiber distribution and superior composite properties.

The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents. Therefore, the claimed effects and physical properties, i.e. a tensile strength of at least 1100 MPa [instant claim 31], would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Claim 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuan *et al.* (US 6,303,697) in view of Jamiolkowski *et al.* (US 4,700,704), as applied to claim 13 above, and

further in view of Okuzaki *et al.* (*Journal of Polymer Science: Part B: Polymer Physics* **1999**, 37, 991-996).

Regarding claim 15: Yuan *et al.* and Jamiolkowski *et al.* renders the basic claimed process obvious [as set forth above with respect to claim 13].

Yuan *et al.* does not teach zone-heating [instant claim 15]. However, Okuzaki *et al.* teaches zone drawing of PLLA fibers [instant claim 15] (pg. 991). Yuan *et al.* and Okuzaki *et al.* are analogous art because they are concerned with a similar technical difficulty, namely the preparation of fibers of biosorbable copolymers. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined zone drawing, as taught by Okuzaki *et al.* in the invention of Yuan *et al.*, and would have been motivated to do so since Okuzaki *et al.* suggests that such zone drawing affords fibers having high orientation with minimal thermal degradation or oxidation occurring (pg. 991), and is an equivalent alternative means of providing fibers of biosorbable copolymers.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-53 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-33 of copending Application No. 10/472908. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed PGA composition and process of producing it substantially overlap in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. See attached form PTO-892.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PEPITONE whose telephone number is (571)270-3299. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARK EASHOO, Ph.D./
Supervisory Patent Examiner, Art Unit 1796
21-Jul-08

MFP
17-July-08